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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,595	12/08/2000	Tad Hogg	1508/3130 (A0854)	2803

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EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/732,595

Applicant(s)

HOGG ET AL.

Examiner

Sandra Snapp

Art Unit

3624

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31, 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 32-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 2-12-2 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-15 are indefinite because they claim a 'system' however it is unclear from the claim language whether the 'system' is actually directed to an apparatus or a method.

Clarification is required.

### ***Claim Rejections - 35 USC § 101***

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-30 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to

Art Unit: 3624

meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning. The Examiner suggests adding some language directed to a computer in the body of the claim language to overcome this rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,6-9, 14-16, 21-24, 28-31 and 35-36 rejected under 35 U.S.C. 102(b) as being anticipated by the Fisher et al. patent (US 5,835,896).

The Fisher reference discloses a method for identifying latent demand for at least one of a plurality of commodities, the method comprising:

Analyzing at least a plurality of initially unaccepted offers for each of the plurality of commodities (col. 6, lines 39-67), and selecting at least one of the plurality of commodities to offer for sale which satisfies at least one criteria based on the analyzing (col. 7, lines 1-7) (claim 1);

Art Unit: 3624

At least one of the plurality of commodities is a combination of two or more items (col. 8, lines 42-67) (claim 6);

Obtaining the offers for each of the plurality of commodities (col. 8, lines 42-67) (claim 7); and

The offers on the plurality of commodities are obtained from at least two different sources (col. 8, lines 42-67) (claim 8).

The Fisher reference discloses a system for identifying latent demand from at least one of a plurality of commodities, the system comprising:

An offer analyzer that analyzes at least a plurality of initially unaccepted offers for each of the plurality of commodities (col. 6, lines 39-67), and a commodity selector that selects at least one of the plurality of commodities to offer for sale which satisfies at least one criteria based on the analyzing (col. 7, lines 1-7) (claim 9);

At least one of the plurality of commodities is a combination of two or more items (col. 8, lines 42-67) (claim 14); and

Further comprising at least one source for the offers for each of the plurality of commodities (col. 8, lines 42-67) (claim 15).

The Fisher reference discloses a computer readable medium having stored thereon instructions for identifying latent demand for at least one of a plurality of commodities which when executed by a processor, cause the processor to perform the steps of:

Art Unit: 3624

Analyzing at least a plurality of initially unaccepted offers for each of the plurality of commodities (col. 6, lines 39-67), and selecting at least one of the plurality of commodities to offer for sale which satisfies at least one criteria based on the analyzing (col. 7, lines 1-7) (claim 16);

At least one of the plurality of commodities is a combination of two or more items (col. 8, lines 42-67) (claim 21);

Obtaining the offers for each of the plurality of commodities (col. 8, lines 42-67) (claim 22); and

The offers on the plurality of commodities are obtained from at least two different sources (col. 8, lines 42-67) (claim 23).

The Fisher reference discloses a method for selling a commodity, the method comprising:

Analyzing a plurality of offers for a plurality of commodities in an auction using a determined criteria (col. 6, lines 39-67), selecting the at least one of the commodities based on the analysis of the determined criteria (col. 7, lines 1-7), and offering to sell the at least one commodity for a price based on an average offer for the commodity (col. 6, lines 46-67) (claim 24);

At least one of the plurality of commodities is a combination of two or more items (col. 8, lines 42-67) (claim 28);

Obtaining the offers for each of the plurality of commodities (col. 8, lines 42-67) (claim 29); and

Art Unit: 3624

The offers on the plurality of commodities are obtained from at least two different sources (col. 8, lines 42-67) (claim 30).

The Fisher reference discloses a system for selling a commodity, the system comprising:

A commodity analyzing apparatus for analyzing a plurality of offers for a plurality of commodities in an auction using a determined criteria (col. 6, lines 39-67), a commodity selecting apparatus for selecting the at least one of the commodities based on the analysis of the determined criteria (col. 7, lines 1-7), and a commodity offering system for offering to sell the at least one commodity for a price based on an average offer for the commodity (col. 6, lines 46-57) (claim 31);

At least one of the plurality of commodities is a combination of two or more items (col. 8, lines 42-67) (claim 35); and

At least one source for the offers for each of the plurality of commodities (col. 8, lines 42-67) (claim 36).

***Allowable Subject Matter***

Claims 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the references disclose dividing each of the average offer for each of the

Art Unit: 3624

plurality of commodities by a total number of items in each of the plurality of commodities to obtain an analyzed value for each of the plurality of commodities.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ausubel, Halbert et al., Silverman et al., Fujisaki, Lupien et al., Micali, Chou et al., Ferstenberg et al., Fraser et al., Brown, Kennedy et al., Franklin et al., Aggarwal et al. and Harrington et al. patents are all directed to electronic forms of auctions or commerce.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

  
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